REMARKS/ARGUMENTS

The Examiner is thanked for the courteous telephone interview granted Applicants' representative on September 9, 2008. During the interview, proposed amended claims 1, 6 and 11 that were submitted in a Response to a Pre-Interview Communication dated August 25, 2008 were discussed. In particular, Applicants' representative identified differences between the amended claims and the cited art of Appelman and Tang. Although agreement with respect to the proposed amended claims was not reached, the Examiner requested that an official Response be prepared and filed explaining the discussed differences in detail for further consideration and/or searching by the Examiner.

Claims 1, 6 and 11 are pending in the present application and were amended. No claims were added or canceled. Support for the claim amendments can be found in the specification, for example, on page 20, line 27-page 21, line 16 and on page 23, line 30-page 24, line 29 and in Figure 7. Reconsideration of the claims is respectfully requested in view of the above amendments and the following comments.

I. 35 U.S.C. § 101

The Examiner has rejected claims 6 and 11 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

In rejecting the claims, the Examiner states:

> Claim 6 recites "computer readable medium" which can be a transmission-type media, such as digital or analog communication links as per lines 7-19 on page 25 of applicant's original specification. That is not conforming 35 U.S.C. 101.
>
> Claim 11 recites "apparatus" and "means for..." without specific hardware references. Compared with claim 6 language, there is no significant difference. It is the evidence that the apparatus is either a hybrid or software per se. This is not conforming 35 U.S.C. 101.

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Claim 6 has been amended to recite a computer program product "stored in a computer readable medium having computer usable program code for managing...." This language is believed to fully satisfy the requirements of 35 U.S.C. § 101.

Claim 11 has been amended to positively recite a data processing system that comprises "a bus system; a storage device connected to the bus system, wherein the storage device includes a set of instructions; and a processing unit connected to the bus system, wherein the processing unit executes the set of instructions to..." This claim now provides specific hardware references and also fully satisfies the requirements of 35 U.S.C. § 101.

Therefore, the rejection of claims 6 and 11 under 35 U.S.C. § 101 has been overcome.

II. 35 U.S.C. § 103, Obviousness

The Examiner has rejected claims 1, 6, and 11 under 35 U.S.C. § 103 as being unpatentable over Appelman, U.S. Patent No. 6,750,881 (hereinafter "Appelman") in view of Tang et al., U.S. Patent No. 5,960,173 (hereinafter "Tang"). This rejection is respectfully traversed.

In rejecting the claims, the Examiner states with respect to Appelman (Reference B):

> Claim 1, 6 and 11 (column 1, lines 53-59: logon status, buddy lists; column 3, lines 48-63: block status code "none", "none except", inclusion list, column 4, lines 37-44: chat room, instant message; Fig. 5, column 4, lines 54-63: display on list of buddies; column 5, lines 16-22: block all with "none" in permissions list table, Buddy Chat invitation; column 5, lines 23-31: allow only the members below, inclusion list, Buddy Chat Invitation; column 5, lines 10-40: block status code for allow a Buddy Chat invitation; Fig. 10, column 6, lines 18-35: send invitation.

and states with respect to Tang (Reference A):

> B does not disclose "in response to receiving..., displaying indication...), A disclosed (Fig. 3-4 column 7, lines 15-37) an open mode is used to display an awareness of other works in proximity for video conference on a computer browser.

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Claims 1, 6 and 11 are generally similar to claims 1, 6 and 11 as proposed in the Response to a Pre-Interview Communication dated August 25, 2008. In addition, however, the

claims have been further amended to specify that "the group of first users comprises a buddy list of the second user" so as to further distinguish over the cited art. Claim 1 as amended herein, is as follows:

1. A computer implemented method for managing user status values in an instant messaging system, wherein the user status values indicate an availability to participate in an instant messaging session, the computer implemented method comprising:

receiving a first request from a second user to designate a do not disturb status that is associated with the second user such that a group of first users cannot initiate a new instant messaging session with the second user, wherein the group of first users comprises a buddy list of the second user;

receiving a second request from the second user to designate a subset of the group of first users such that the subset of the group of first users is authorized to initiate the new instant messaging session with the second user while a remainder of the group of first users cannot initiate the new instant messaging session with the second user;

the second user receiving a request from a first user of the group of first users to initiate the new instant messaging session with the second user;

determining whether the second user has designated the do not disturb status;

in response to determining that the second user has designated the do not disturb status, determining whether the first user of the group of first users is included in the subset of the group of first users;

in response to determining that the first user is not included in the subset of the group of first users, denying the request from the first user to initiate the new instant messaging session with the second user, and displaying a message to the first user that the new instant messaging session cannot be initiated; and

in response to determining that the first user is included in the subset of the group of first users, displaying chat session windows for the first user and the second user for initiating the new instant messaging session with the second user.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka,* 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are… determined; differences between the prior art and the claims at issue are… ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). "Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the

background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). "*Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.* Id. (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006))."

In the present case, the Examiner has not established a *prima facie* case of obviousness in rejecting the claims because neither Appelman nor Tang nor Appelman in view of Tang teaches or suggests all the claim limitations.

Appelman is directed to a mechanism for tracking the login status of selected users in an online or network system and for displaying that information in real time to a tracking user. In Appelman, a user can create many buddy lists, and the system matches co-users currently logged on with entries in the various buddy lists.

Tang is directed to a mechanism that enables a worker to identify other workers that are "nearby" in terms of the type of work they are doing. Tang teaches that two workers are considered "task proximate" when both are accessing similar types of data, and that when a worker is aware of other workers who are task proximate, there is an increased likelihood of an interaction to support their tasks.

Applicants respectfully submit that neither Appelman nor Tang nor Appelman in view of Tang discloses or suggests the claim 1 features of "receiving a first request from a second user to designate a do not disturb status that is associated with the second user such that a group of first users cannot initiate a new instant messaging session with the second user, wherein the group of first users comprises a buddy list of the second user", and "receiving a second request from the second user to designate a subset of the group of first users such that the subset of the group of first users is authorized to initiate the new instant messaging session with the second user while a remainder of the group of first users cannot initiate the new instant messaging session with the second user." Applicants further respectfully submit that the references also do not disclose or suggest the claim 1 features of "determining whether the second user has designated the do not disturb status", "in response to determining that the second user has designated the do not disturb status, determining whether the first user of the group of first users is included in the subset of the group of first users", or "in response to determining that the first user is not included in the

subset of the group of first users, denying the request from the first user to initiate the new instant messaging session with the second user, and displaying a message to the first user that the new instant messaging session cannot be initiated; and in response to determining that the first user is included in the subset of the group of first users, displaying chat session windows for the first user and the second user for initiating the new instant messaging session with the second user."

Initially, Applicants respectfully submit that Appelman in view of Tang does not disclose or suggest "receiving a first request from a second user to designate a do not disturb status that is associated with the second user such that a group of first users cannot initiate a new instant messaging session with the second user, wherein the group of first users comprises a buddy list of the second user", and "receiving a second request from the second user to designate a subset of the group of first users such that the subset of the group of first users is authorized to initiate the new instant messaging session with the second user while a remainder of the group of first users cannot initiate the new instant messaging session with the second user." Neither Appelman nor Tang relates to or in any way discloses a mechanism by which a user requests that a do not disturb status be designated so that a group of other users cannot initiate an instant messaging session, and also requests that a subset of the group of other users be designated as authorized to initiate the instant messaging session. Appelman merely discloses a mechanism for tracking the status of users on buddy lists. Tang is cited only as disclosing the displaying features of the claims. Therefore, Appelman in view of Tang does not disclose or suggest "receiving a first request from a second user to designate a do not disturb status that is associated with the second user such that a group of first users cannot initiate a new instant messaging session with the second user, wherein the group of first users comprises a buddy list of the second user", and "receiving a second request from the second user to designate a subset of the group of first users such that the subset of the group of first users is authorized to initiate the new instant messaging session with the second user while a remainder of the group of first users cannot initiate the new instant messaging session with the second user" as recited in amended claim 1, and amended claim 1 patentably distinguishes over the cited art for this reason. .

Appelman in view of Tang also does not teach or suggest "determining whether the second user has designated the do not disturb status" as now recited in claim 1, or "in response to determining that the second user has designated the do not disturb status, determining whether

the first user of the group of first users [that has requested to initiate an instant messaging session] is included in the subset of the group of first users" as now recited in claim 1. Appelman simply provides a mechanism for providing a permissions list specifying the status of individuals with respect to being entered on buddy lists. Appelman does not disclose or suggest determining whether a do not disturb status has been designated, and determining whether a user of a group of users is included in a subset of a group of users in response to determining that a do not disturb status has been designated.

Claim 1, accordingly, patentably distinguishes over the cited art for this reason, as well.

Yet further, Appelman in view of Tang also does not teach or suggest "in response to determining that the first user is not included in the subset of the group of first users, denying the request from the first user to initiate the new instant messaging session with the second user, and displaying a message to the first user that the new instant messaging session cannot be initiated; and in response to determining that the first user is included in the subset of the group of first users, displaying chat session windows for the first user and the second user for initiating the new instant messaging session with the second user." As indicated above, Appelman never determines whether a first user of a group of first users that has requested to initiate an instant messaging session is included in the subset of the group of first users, and, accordingly, cannot disclose or suggest denying the request if it is determined that the first user is not included in the subset of the group of first users, or displaying chat session windows if it is determined that the first user is included in the subset of the group of first users.

Therefore, claim 1 patentably distinguishes over the cited art for this reason as well.

As indicated above, Tang is cited as disclosing the displaying features of the claims and does not supply the deficiencies in Appelman as described in detail above.

Therefore, the Examiner has not established a *prima facie* case of obviousness in rejecting claim 1, and claim 1 patentably distinguishes over the cited art in its present form.

Claims 6 and 11 have been amended in a similar manner as claim 1 and also patentably distinguish over the cited art in their present form for similar reasons as discussed above with respect to claim 1.

Therefore, the rejection of claims 1, 6, and 11 under 35 U.S.C. § 103 has been overcome.

III. Conclusion

For at least all the above reasons, claims 1, 6 and 11 patentably distinguish over the cited art and this application is believed to be in condition for allowance. It is, accordingly, respectfully requested that the Examiner so find and issue a Notice of Allowance in due course.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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